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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,210	06/09/2006	Manfred Essich	1549.008	2191
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Peter L. Berger Levisohn Berger & Langsam 805 Third Avenue 19th Floor New York, NY 10022			EXAMINER RODRIGUEZ, RUTH C	
			ART UNIT 3677	PAPER NUMBER
			MAIL DATE 12/30/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/582,210

**Applicant(s)**

ESSICH, MANFRED

**Examiner**

RUTH C. RODRIGUEZ

**Art Unit**

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement (IDS) submitted on 06 February 2007 has been considered by the examiner.

### ***Claim Objections***

2. Claim 7 is objected to because of the following informalities: Claim 7 recites the limitation "the body" in the second line. There is insufficient antecedent basis for this limitation in the claim. Correction is required.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by British Patent Document UK 2 084 855 A (UK '855).

An article of jewelry, in a body (18) with an opening (16) being provided in which an element of ornamentation (20) is accommodated, in particular a precious stone or an ornamenting stone. The opening of the body of the article of jewelry accommodating the element of ornamentation (Figs. 1 and 2). A support for the element of ornamentation is formed by the depth of insertion of the element of ornamentation in the opening of the body of the article of jewelry and being defined by a lower edge of the element of ornamentation that is supported at least selectively (Figs. 1 and 2). The article of jewelry comprises a securing element (edges of 26 over the element of ornamentation) extending at least along a part of the circumference of the opening (Figs. 1 and 2). The securing element is formed by reaming the opening of the body of the article of jewelry in an area surrounding the opening and subsequently stabilizing the material which was eroded from the area surrounding the opening of the body (Figs. 1 and 2). The securing element acts upon an upper edge of the element of ornamentation at least selectively and the area surrounding the opening of the body of the piece of jewelry is at least partially beveled (Figs. 1 and 2).

The securing element is formed extending substantially along the whole circumference of the opening (Figs. 1 and 2)

The opening comprises an upper portion with a diameter which is larger than a diameter of the element of ornamentation and a lower portion with a diameter which is smaller than the diameter of the element of ornamentation (Fig. 1)

A transition portion is formed between the upper portion and the lower portion of the opening that constitutes the support for the element of ornamentation (Figs. 1 and 2).

The opening has a means (compressed material) for protection against twisting of the element of ornamentation being provided (Figs. 1 and 2).

The article of jewelry is formed as a ring, a pendant, a part of a link of a chain, as jewelry for ears, as part of a clock or a watch or of a watchband (Page 1, lines 5-8).

A method for manufacturing an article of jewelry (18), especially a ring (Page 1, lines 5-8), in the body (18) of which an opening (16) is provided in which an element of ornamentation (20) is accommodated, in particular a precious stone or an ornamenting stone (Figs. 1 and 2). A first step of the method provides the opening in the body of the piece of jewelry with a diameter that is smaller than the diameter of the element of ornamentation to be inserted into the opening (Fig. 1). A subsequent step forms an upper portion of the opening with a diameter that is equal to or larger than the diameter of the element of ornamentation such that between the upper portion of the opening with the diameter and a lower portion of the opening with the smaller diameter there is a transition portion serving as a support for the element of ornamentation (Figs. 1 and 2). The element of ornamentation is inserted into the opening and set onto the support (Fig. 1). A subsequent step the material of the body of the article of jewelry is eroded in an area (26) surrounding the opening and that the eroded material is brought to the element of ornamentation and accommodated in the opening of the body (Fig. 2). The erosion of material in the area of the opening is executed by reaming the area surrounding the opening (Figs. 1 and 2). A securing element (edge of 26 over the element of ornamentation) for the element of ornamentation is formed from the eroded and later restabilized material such that an upper edge of the element of ornamentation

is acted upon at least selectively by the formed securing element. The element of ornamentation is fixed in position in the opening and the area surrounding the opening is beveled at least partially by this reaming (Figs. 1 and 2)

The securing element is formed extending substantially the whole circumference of the opening (Figs. 1 and 2)

The method is characterized in that a means (compressed material) for protection against twisting of the element of ornamentation is provided in the support (Figs. 1 and 2).

A tool for the implementation of the method is characterized in that the tool (10) comprises a tool body having an interior in which the element of ornamentation may be accommodated and that the tool comprises a reaming area at its front face (Fig. 1).

The reaming area is divided into a plurality of segments (Fig. 2).

The reaming area is formed extending inclined to the outer surface of the tool body (when made along surface 12 that is inclined).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over UK '855 in view of Yamamoto (US 5,475,910).

UK '855 discloses an article of jewelry having all the features mentioned above for the rejection of claims 1-12. UK '855 fails to disclose that the tool body of the tool is disposed at a shank. Yamamoto teaches an article of jewelry (1) in a body with an opening (16) being provided in which an element of ornamentation (2) is accommodated, in particular a precious stone or an ornamenting stone. The opening of the body of the article of jewelry accommodating the element of ornamentation (Figs. 1-10). A support for the element of ornamentation is formed by the depth of insertion of the element of ornamentation in the opening of the body of the article of jewelry and being defined by a lower edge of the element of ornamentation that is supported at least selectively (Figs. 1-10). The article of jewelry comprises a securing element (edges of the opening) extending at least along a part of the circumference of the opening (Figs. 1-10). The securing element is formed by reaming the opening of the body of the article of jewelry in an area surrounding the opening and subsequently stabilizing the material which was eroded from the area surrounding the opening of the body (Figs. 1-10). The A tool comprises a tool body. The tool body of the tool is disposed at a shank (38) (Fig. 10). The shank is a driving spindle that can be connected rigidly to the tool body (C. 11, L. 15-24). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the tool body of the body being disposed at a shank as taught by Yamamoto in the article of jewelry disclosed by UK '855. Doing

so, serves to connect the tool body to a spindle in accordance with the teachings of Yamamoto.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Dover (US 795,109), Burri (US 2,261,958), Brzozowski (US 4,566,294), Favre (US 5,044,177), Udco (US 5,218,839) and Espinosa et al. (US 2006/0123846) are cited to show state of the art with respect to articles of jewelry that have some of the features being claimed by the current application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth C Rodriguez whose telephone number is (571) 272-7070. The examiner can normally be reached on M-F 07:15 - 15:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Victor D. Batson can be reached on (571) 272-6987.

Submissions of your responses by facsimile transmission are encouraged. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase the patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will



eliminate Post Office processing and delivery time as well as PTO's mailroom processing and delivery time. For a complete list of correspondence **not** permitted by facsimile transmission, see MPEP § 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee that the applicant is paying by check **should not be** submitted by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP § 512). The following is an example of the format the certification might take:

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(Typed or printed name of person signing this certificate)

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP § 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response has been transmitted by facsimile will cause further unnecessary delays in the processing of your application, duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-6640.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/RCR/  
Ruth C. Rodriguez  
Patent Examiner  
Art Unit 3677

rcr  
December 31, 2008

/Robert J. Sandy/  
Primary Examiner, Art Unit 3677